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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,472	03/08/2000	NOBORU YANAGISAWA	P4982A	1753

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EPSON RESEARCH AND DEVELOPMENT INC
INTELLECTUAL PROPERTY DEPT
150 RIVER OAKS PARKWAY, SUITE 225
SAN JOSE, CA 95134

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/521,472

Applicant(s)
Yanagisawa et al

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 6, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) 1-25, 39, 41, and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7, & 8 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election of Group II (claims 26-38 and 40) in Paper No. 11 is acknowledged.

Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-25, 39, 41, and 42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 11.

3. The Examiner cautions that claims 35-38 as currently claimed are not patentably distinct from claims 26-34. Therefore a restriction between claims 26-34 and 35-38 would be improper. However, if Applicants amend either group of claims so that they are no longer patentably distinct, a restriction between the two groups would likely follow.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 35-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete, tangible result.

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See *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). Internal “storing” does not produce a result. The Examiner suggests outputting, printing, or displaying some data to overcome this rejection.

6. Claims 35-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

The Examiner respectfully requests Applicants to expressly state whether they intend to claim a product claim or a process claim. It appears Applicants are claiming a medium (a product claim placing it within the §101 category of a machine) and yet are still attempting to claim a method or process claim (“the method comprising”).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

8. Claims 30-32, 35-38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. Claims 30-32 are indefinite because the claims fail to recite any additional method steps. While the claims need not recite all of the operating details, a method claim should at least

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recite a positive, active step. *Ex parte Erlich*, 3 USPQ2d 1011, 1017 (B.P.A.I. 1987) (citations omitted).

b. Claims 35-38 are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. It is therefore unclear whether Applicants are claiming a process or a machine. See the §101 rejection above, MPEP §2173.05(p) II, or *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990).

c. In claim 29, it is unclear what “based on said consumer information received in said check-out information receiving step” is referring to since it is not known what the dependent clause is modifying.

d. In claim 40, it is unclear who is “reading said ID.”

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

10. Claims 26-38 and 40, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky et. al. (U.S. 6,334,109 B1). Kanevsky et. al. discloses the

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following: receiving advertising information (inherent since how else would it be able to print an advertisement); calculating a billing amount (inherent since advertising is rarely free) based on the advertising information received (again inherent since advertisement costs are based upon size of the ad, duration, black and white v. color, just text or text and images); confirming payment of billing amount (payment of the cost of the ad); storing the information received; the advertising information includes images (inherent in advertisements); receiving check out information (items purchased, etc); retrieving stored advertisement information (the ad size, content, etc); synthesizing the received check-out information with the retrieved advertising information and generating printed data (the receipt with the ad and advertisement); the checkout information includes customer information (stored on the server); selecting and retrieving one advertising information (an ad) from a plurality of advertising information (a plurality of ads); the advertising information includes a period for running an advertisement (inherent since virtually no ad runs forever); the advertising information includes characteristics of an advertisement recipient (the ad information is based in part upon the customer) including gender (column 8, lines 34-37); the ad is printed at whatever size; the billing is based upon duration (inherent in virtually all ads); displaying (in this case printing) an advertisement that is the same size as the printing size of an advertisement (inherent); printing a temporary registration containing an ID (the transaction ID on the receipt); reading the ID (by the manager, clerk, or customer); and registering advertisement information in the server (in the advertisement server).

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11. Functional recitation(s) using the word “for” (e.g. “for billing for advertisements printed on receipts” as recited in claim 26) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

12. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60

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However, if Applicants do desire any claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate the claim limitation at issue² and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one

USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

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reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).³

The Examiner cautions that no new matter is allowed.

Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to give all claim limitations their ordinary and accustomed meaning. The claims are then interpreted with their “broadest reasonable interpretation . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁴ Applicants are cautioned that even though claim interpretation begins with this presumption, any interpretation disclaimed during prosecution may still further limit that claim

³ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁴ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

13. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 26-38 and 40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et. al.⁵ It is the Examiner's principle position that the claimed are anticipated by Kanevsky et. al. because the inherency's discussed above. Just because Kanevsky et. al. is silent as to the billing methods does not mean the billing

⁵ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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method are absent from the Kanevsky et. al.'s embodiment of the invention. To the contrary, since most advertisers must pay for their advertisements, based upon a preponderance of the evidence standard, the missing elements are clearly inherent in the Kanevsky et. al. embodiments.

However if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Kanevsky et. al. disclosure to include confirming payment after calculating a billing amount, and receiving image information. Such a modification would have allowed for receiving money for advertising.

16. Finally, claims 26-38 and 40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et. al. in view of Dedrick (U.S. 5,724,521). While its the Examiner's principle position that the methods are anticipated, Dedrick directly teaches billing advertisers based upon the match to the customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kanevsky et. al. as taught by Dedrick to include the fee processes. Such a modification would have allowed advertisers to pay for access to individual customers based on how desirable it is for the advertiser to have access to those particular customers.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure includes the following: McCormick (U.S. 6,138,569); Revill (U.S. 6,120,062);


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Schreadley, Jr. (U.S. 5,887,903); McCormick (U.S. 5,819,665); Dedrick (U.S. 5,752,238); and Shannon (U.S. 4,723,794).


18. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

19. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER
7/18/02

AJF
July 18, 2002

 7/22/02
ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600